REMARKS/ARGUMENTS

By this Amendment, claims 15-16 are canceled. Claims 1-14 are pending.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Rejection under 35 USC 102(b)

Claims 1-2 and 15 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 4,943,590. This rejection is respectfully traversed.

As an initial matter, without acquiescing to the propriety of the Examiner's rejection, claim 15 has been canceled herein. The rejection is moot with regard to claim 15, and therefore reconsideration and withdrawal of the rejection of claim 15 at least is requested.

The Examiner admits that the instant claims and the prior art disclosure are different in the measurements of crystallinity by powdered X-ray diffraction, but argues that the innate nature of a product, such as the X-ray diffraction pattern does not demarcate from a product which although was not measured by X-ray but are made by the same identical process of crystallization from acetone as the original claims and the specification (Office Action at page 2).

The Examiner further sets forth that it is well recognized in the art that X-ray diffraction pattern although useful must be carefully evaluated (See US Pharmacopia). Small difference in X-ray lines does not necessarily imply new forms. In addition, it is well known that powder X-ray pattern are unreliable without factual evidence in comparative measurements that artifacts are not at issue (see Davidovich et al.) and the

same crystal when taken in powdered process can provide misleading pattern (see Bernstein p.118) while same X-ray pattern can be different compounds. Such degree of understanding offered the scientific basis that powdered X-ray diffraction pattern alone absent of complete multiple character of a product which was made by identical process does not demarcate from the prior art. Thus, anticipation was found (Office Action at page 2).

However, the art teaches that XRPD is reliable for determination of distinct polymorphic forms. As set forth in the response filed 11/09/2007, the Bernstein reference (cited on the PTO-892 of 07/08/2007) teaches that in the case of polymorphic mixtures, or the determination of polymorphic purity, the choice of analytical method is considerably more restricted, and X-ray diffraction is one of the most definitive techniques, the Davidovich reference teaches that powder X-ray diffraction is one of the most useful and widely used analytical methods to determine polymorphs and quantify the forms present in a mixture, US Pharmacopia teaches that diffraction established for a single crystal can be used to support specific powder pattern as being, truly representative of a single phase. Therefore, the art teaches that XRPD data is reliable to differentiate between polymorphic forms.

The Examiner further sets forth that absent a side-by-side comparison, there is no evidence that mere deletion of the solvent acetone from the claim has actually produced a "different" product. The Examiner alleges that every single evidence in obtaining form I in the specification (see examples 1, 2, 5) is from acetone (Office Action at page 3).

However here, claims 1-2 are directed to novel polymorphic form I of citalopram

oxalate, characterized by an x-ray powder diffraction pattern having peaks expressed as 2θ at about 6.9, 8.9, 10.8, 13.4, 14.0, 16.3, 17.6, 18.6, 19.1, 19.5, 21.2, 22.8, 23.1, 24.2, 24.5, 25.3, 27.3 degrees. The '590 patent does not disclose a compound with this XRPD pattern. In addition, the methods as disclosed in the '590 patent are distinct from the methods of the instant application. Here, the Specification discloses the manner and process for making and using the claimed invention, including working examples which show the process of making the claimed invention. For example, the Specification discloses a process of making Form I (S)-citalopram using ethyl acetate, methyl tert-butyl ether, dioxane and acetonitrile (see ¶[0008] and ¶[0009]).

In addition, there is not a reasonable expectation that different solvents would result in the formation of (S)-citalopram form I because it is known in the art that the use of different solvents will produce different crystalline forms of a product. Banga et al. teaches (Banga S, Chawla G, Bansal AK. New trends in crystallization of active pharmaceutical ingredients. Business Briefing: Pharmagenerics 2004, 1-5 (Nov)) (pages 2-3):

> The concept that different crystalline modifications arise under varied experimental conditions demands the use of a diverse medley of crystallisation approaches to explicate the polymorph spectrum. Currently, the polymorph screen is a jumbled affair based mostly upon hit and trial bases. Crystallisation from solution (single solvent or solvent mixtures) and non-solvent methods such as sublimation, thermal treatment, desolvation, processing (grinding) and crystallisation from melting are the commonly used traditional approaches for polymorph screening. A meticulous consideration of the factors of solvent recrystallisation like solvent polarity, degree of supersaturation, temperature along with the cooling profile, additives, seeds, pH and agitation rate aids in elucidating the complete polymorphic picture of the drug.[9] However, the traditional crystallisation methods are exhausting, time-consuming and may be liable to miss metastable forms having an energy difference of less than

10kJ/mole, as observed in the case of paracetamol and chlorthalonil.[5] Therefore, innovative techniques allowing generations of 'crystal mutants' would prove to be of high value.

Therefore, the assumption that crystallization from acetone will yield the same polymorphic form as crystallization from ethyl acetate, methyl tert-butyl ether, dioxane or acetonitrile, has no basis in fact.

Accordingly, the art teaches that XRPD data is reliable to differentiate between different polymorphic crystalline forms. Applicant has provided XRPD data for the claimed polymorphic form of citalopram oxalate, and demonstrated that the form as taught in the '590 patent is distinct from the claimed polymorphic form.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 112, first paragraph

Claims 1-2 and 15 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Claims 3-4, and 6-7 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

These rejections were set forth by the Examiner together, and will be addressed together.

Without acquiescing to the propriety of the Examiner's rejection, claim 15 has been canceled herein. The rejection is moot with regard to claim 15, and therefore reconsideration

and withdrawal of the rejection at least of claim 15 is requested.

The Examiner sets forth that the state of the art of polymorph recovery is highly unpredictable, citing the Kirk-Othmer Encyclopedia of Chemical Technology Copyright, which allegedly teaches that many uncertain factors determine morphology, and specifically that the appearance of the crystalline product and its processing characteristics (such as washing and filtration) are affected by crystal habit (i.e., the general shape of a crystal). Relative growth rates of the faces of a crystal determine its shape. Faster growing faces become smaller than slower growing faces and, in the extreme case, may disappear from the crystal altogether (Office Action at pages 4-5).

The Examiner sets forth that the reference also teaches that polymorphism is a condition wherein crystalline form is intimately associated with processing ("*Polymorphism* is a condition in which chemically identical substances may crystallize into different forms. Each form is, however, only stable (thermodynamically) in a certain range of temperature and pressure. The Examiner sets forth that transitions from one polymorphic form to another may be accompanied by changes in process conditions (temperature, pressure, shear or solution composition), transitions from one polymorphic form to another and lead to formation of a solid product with unacceptable properties (e.g., melting point or dissolution rate)(Office Action at page 5).

The Examiner argues that if the product made by using ethylacetate, methyl tert-butyl ether and acetonitrile is different from the product made using acetone as exemplified in examples 1, 2 or 5, then, such product must be supported by side-by-side comparison with the prior art product made by acetone, and alleges that every exemplification wherein form I was obtained employed acetone (see examples 1, 2, 5). The Examiner alleges that no where in the

specification provided description or enablement as to what is the product being made by using ethylacetate, methyl tert-butyl ether and acetonitrile (Office Action at page 5).

The Examiner further alleges that the instant specification, however, provided no description or enablement that the instantly amended process would produce form I as described by examples 1, 2, or 5 which used exclusively acetone, and concludes that claims 1-2 would be considered to contain new matter since a product which is different from those made in acetone was not disclosed (Office Action at page 5).

However, to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406; Amgen, Inc. v. Chugai Pharmaceutical, 927 F.2d 1200, 1206,

18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

In addition, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. United States v. Telectronics, Inc., 857 F.2d 778, 785 (Fed. Cir. 1988). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 USC 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. In re Marzocchi, 439 F.2d 220, 224 (CCPA 1971).

Here, the claims are described because the specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The claims are enabled because one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

Here, the claims are enabled because there is not any reason to doubt the objective truth of the statements contained in the Specification for enabling support. The Specification discloses the manner and process for making and using the claimed invention, including working examples which show the efficacy of the claimed invention. For example, the Specification discloses a process of making Form I (S)-citalopram using ethyl acetate, methyl tert-butyl ether, dioxane and

acetonitrile (see ¶[0008] and ¶[0009]).

Thus, given the teachings of the Specification, in light of the further experimentation carried out by Applicant using the disclosed methods, the quantity of experimentation required is not excessive in view of the subject matter of the claims. The Specification sets forth several methods for producing a (S)-citalopram, and the two novel crystalline forms of (S)-citalopram. Working Examples are also provided, as well as detailed information as to the methods. This information can be used by one of ordinary skill in the art to determine appropriate solution conditions to practice the claimed process, without undue experimentation.

In addition, the patent specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Applicant clearly has established possession of the invention that is now claimed.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 102(e)

Claims 8-9, and 16 stand rejected under 35 U.S.C. 102(e) as being anticipated by US 6,916,941. This rejection is respectfully traversed.

Without acquiescing to the propriety of the Examiner's rejection, claim 16 has been canceled herein. The rejection is moot with regard to claim 16, and therefore reconsideration and withdrawal is requested.

The Examiner admits that that the instant claims and the prior art disclosure different in the measurements of crystallinity by powdered X-ray diffraction. The Examiner sets forth that the innate nature of a product, such as the X-ray diffraction pattern does not demarcate from a product which although was not measured by X-ray but are made by the same identical process

of crystallization from acetone as the claims (Office Action at page 6).

The Examiner sets forth that a product cannot be separated from its innate nature such as the physical properties of the product i.e. x-ray diffraction pattern, and argues that the product as claimed which was described by the specification to be made by any alcoholic solvent. The Examiner argues that the deletion of ethanol from the process of making does not obviate the anticipation. If the product which is made by methanol or isopropyl alcohol is a different product from the one made by ethanol, only a side-by-side comparison of the instant product with the prior art product can support such an allegation (Office Action at page 5).

However, the art teaches that XRPD is reliable for determination of distinct polymorphic forms. As set forth above, the Bernstein reference teaches that in the case of polymorphic mixtures, or the determination of polymorphic purity, the choice of analytical method is considerably more restricted, and X-ray diffraction is one of the most definitive techniques, the Davidovich reference teaches that powder X-ray diffraction is one of the most useful and widely used analytical methods to determine polymorphs and quantify the forms present in a mixture, US Pharmacopia teaches that diffraction established for a single crystal can be used to support specific powder pattern as being, truly representative of a single phase. Therefore, the art teaches that XRPD data is reliable to differentiate between polymorphic forms.

In addition, while the '941 Christensen patent discloses a method for the manufacture of crystalline particles of (S)-citalopram oxalate by crystallization from ethanol, in the method of synthesis of Form II (S)-citalopram oxalate of the instant claims is not dissolved from ethanol or acetone, but from methanol or isopropyl alcohol. As set forth above, the use of different solvents will produce different crystalline forms of a product. Therefore, the assumption that

crystallization from methanol or isopropyl alcohol will yield the same polymorphic form as crystallization from acetone or ethanol has no basis in fact.

Accordingly, the art teaches that XRPD data is reliable to differentiate between different polymorphic crystalline forms. In addition, the Brittain reference, cited by the Examiner, teaches that methodologies other than XRPD data must be considered as sources of supporting and ancillary information. Applicant has provided XRPD data for the claimed polymorphic form, and shows the polymorphic forms as taught in the '941 patent are distinct from the claimed polymorphic form.

Accordingly, reconsideration and withdrawal of the rejection under 35 USC 102(e) is respectfully requested.

Rejection under 35 USC 112, first paragraph

Claims 8-9 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Claims 10-11, 13-14, 16 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

These rejections were set forth by the Examiner together, and will be addressed together.

Without acquiescing to the propriety of the Examiner's rejection, claim 16 has been canceled herein. The rejection is moot with regard to claim 16, and therefore reconsideration and withdrawal is requested.

The Examiner sets forth that if the product made by using methanol or isopropanol is *different* from the product made using ethanol as exemplified in examples 3-4 p.5, then, such product must be supported by side-by-side comparison with the prior art product or product

made in ethanol. (Office Action at page 7).

Here, the claims are described because the specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The claims are enabled because one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

Also, the claims are enabled because there is not any reason to doubt the objective truth of the statements contained in the Specification for enabling support. The Specification discloses the manner and process for making and using the claimed invention, including working examples which show the efficacy of the claimed invention. For example, the Specification discloses a process of making Form II (S)-citalopram using ethyl acetate, methyl tert-butyl ether, dioxane and acetonitrile (see ¶[0009] and ¶[0010]).

Thus, given the teachings of the Specification, in light of the further experimentation carried out by Applicant using the disclosed methods, the quantity of experimentation required is not excessive in view of the subject matter of the claims. The Specification sets forth several methods for producing a (S)-citalopram, and the two novel crystalline forms of (S)-citalopram. Working Examples are also provided, as well as detailed information as to the methods. This information can be used by one of ordinary skill in the art to determine appropriate solution conditions to practice the claimed process, without undue experimentation.

In addition, the patent specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Applicant clearly has established possession of the invention that is now claimed.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 112, first paragraph

Claims 1-16 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

Without acquiescing to the propriety of the Examiner's rejection, claims 15-16 have been canceled herein. The rejection is moot with regard to claims 15-16, and therefore reconsideration and withdrawal is requested.

The Examiner argues that if the form I made by using ethylacetate, methyl tert-butyl ether and acetonitrile is different from the product made using acetone which is supported by side-by-side comparison with the prior art product made by acetone, then, such product and process are new matter which lacks description. (Office Action at page 8).

The Examiner further argues that if the form II made by using methanol or isopropanol is different from the product made using ethanol which if supported by side-by-side comparison with the prior art product made by ethanol, then, such product and process are new matter which lacks description, because the specification declares under oath that the same identical product was made with ethanol, methanol or isopropanol (Office Action at page 8).

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Moba, B.V. v. Diamond Automation,

Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406; Amgen, Inc. v. Chugai Pharmaceutical, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

Here, the Specification discloses the manner and process for making and using the claimed invention, including working examples which show the efficacy of the claimed invention. For example, the Specification discloses a process of making Form I (S)-citalopram using ethyl acetate, methyl tert-butyl ether, dioxane and acetonitrile (see ¶[0008] and ¶[0009]). The Specification discloses the manner and process for making and using the claimed invention, including working examples which show the efficacy of the claimed invention. For example, the Specification discloses a process of making Form II (S)-citalopram using ethyl acetate, methyl tert-butyl ether, dioxane and acetonitrile (see ¶[0009] and ¶[0010]).

Therefore, the patent specification describes the claimed invention in sufficient detail that

one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Applicant clearly has established possession of the invention that is now claimed.

Accordingly reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 112, first paragraph

Claims 15-16 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

Without acquiescing to the propriety of the Examiner's rejection, claims 15-16 have been canceled herein. The rejection is moot, and therefore reconsideration and withdrawal is requested.

Rejection under 35 USC 103(a)

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Boegesoe et al. US 4,943,590 or Christensen et al. US 6,916,941. In view of Cheronis supplemented with Sanches et al. US 6,960,613, US 6,768,011 or US 7,112,686. This rejection is respectfully traversed.

Without acquiescing to the propriety of the Examiner's rejection, claims 15-16 have been canceled herein. The rejection is moot with regard to claims 15-16, and therefore reconsideration and withdrawal is requested.

The Examiner sets forth that Boegesoe et al. '590, col. 6, lines 66-68, col. 10, claims 1 and 3 or Christensen et al. col. 5-6, examples 1-2, disclosed products prepared by allegedly identical processes which anticipate the claims (see section 3 supra) (Office Action at page 11).

The Examiner sets forth that the difference between the instant claims and the prior art

product is that the powdered X-ray diffraction pattern was included or a variation of solvent was employed in preparing the product. the Examiner cites Cheronis as allegedly teaching that crystallization/recrystallization is a routine laboratory tool in purifying compounds, and argues that the employment of variation of common laboratory solvent would be an routine operation for such process (see p. 31-33). Sanches '613 taught that for the particular compound citalopram oxalate, the same obvious routine recrystallization skill in purification is desirable (see col. 3, lines 30-35); Rock et al. '011 disclosed the employment of acetone for crystallization (see col. 6, line 1); Humble et al. (l02(e) reference) taught that recrystallization of enantiomeric citalopram oxalate can employ alcohols, ketones, acetonitrile etc. (see col. 5, lines 22-25, col. 6, lines 8-11) (Office Action at page 11).

The Examiner argues that the references provided the particular process to obtain the crystalline form of s-citalopram oxalate with suggestions that further purification is desirable using routine recrystallization skill with common laboratory solvents, and that further motivated by the operable solvents employed by analogous art, the particular choices among the common laboratory solvents are well delineated and suggested (Office Action at page 11).

The Examiner argues that the motivation of obtaining purer, better crystals would have suggested to one skilled in the art to employ those alternative choices of solvents explicitly disclosed by Sanches, Rock or Humbel during crystallization of citalopram oxalate with the expectation that crystalline forms would be resulted. The Examiner argues that it is well recognized by artisan in the field that "More than half of the pharmaceutical compounds exhibits polymorphism..." (see Doelker CA138 supra) or ". ..in the strictest sense, polymorphs are . ...the same pure substance. .." and patentability of new crystalline form are normally granted on the

basis of an advantage in terms of stability, formulation, solubility... ..etc. (see Brittain p. 2, 185) (Office Action at page 12).

With regard to the specific field of crystallization of citalopram salt the Examiner cites the following references: US 2002/0177722, p. 7, example 7; US 2004/0259940, p.6 example 4; US 2007/0117992, p.8, example 5; US 2007/0129561, p.26, example 42; US 2008/0161584, p. 8, last two paragraph; US2005/0137255 p. 4, example 1. The Examiner concludes that therefore, both conventional and specific teaching would render the process of picking and choosing alternative operable solvent for crystallization of citalopram salt prima facie obvious to one having ordinary skill including those specific solvent limitations in the dependent claims (Office Action at page 12).

However, the claims are patentable over the combination of '590 Boegesoe and '941 Christensen in view of Cheronis supplemented with '613 Sanches, '011 Rock or '686 Humble references for the following reasons. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). MPEP 2143. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in

judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). MPEP 2143.03. It is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. (KSR v Teleflex, 12 S.Ct. 1727, 1740 (US 2007)). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. (*Id.*).

Here, not every element of the claims is taught or suggested in the combination of the '590 Boegesoe and '941 Christensen in view of Cheronis supplemented with '613 Sanches, '011 Rock or '686 Humble references. The instant claims are directed to a novel polymorph of (S)-citalopram oxalate. However, the prior art relied upon by the examiner does not teach or suggest the specific polymorphs as claimed by Applicant. The examiner failed to demonstrate that the prior art even recognized that the claimed compound exists in different polymorphic forms, or that there is a known or obvious way to manufacture the specific polymorphic form claimed. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic (see above). Here, the Examiner has assumed, without providing any evidence that the methods of producing (S)-citalopram oxalate in the '590 Boegesoe patent can be altered to produce the claimed polymorphs. However, there is no basis for this assumption because, as set forth in the response of 11/09/2007, the use of different solvents will produce different crystalline forms of a product

(see U.S. Patent Application Publication No. 2004/0102523 (Broquaire et al.), cited on the IDS of 11/09/2007). Therefore, the assumption that crystallization from ethyl acetate, methyl tert-butyl ether, acetonitrile, methanol or isopropyl alcohol will yield the same polymorphic form as crystallization from acetone or ethanol has no basis in fact.

In addition, there is no motivation for one of skill in the art to alter the methods of the '590 Boegesoe patent to arrive at the claimed method, and no reasonable expectation of success. There is no teaching or suggestion within the '941 Christensen in view of Cheronis supplemented with '613 Sanches, '011 Rock or '686 Humble references to alter the method as taught by the '590 Boegesoe patent to arrive at the instantly claimed method. The Examiner argues that one having ordinary skill in the art is well aware of all the pertinent art in the field. The above references provided the particular process to obtain the crystalline forms of (S)-citalopram oxalate with suggestions that further purification is desirable using routine recrystallization skill with common laboratory solvents. Further motivated by the operable solvents employed by analogous art, the particular choices among the common laboratory solvents are well delineated and suggested. However, the '590 Boegesoe patent does not disclose or suggest methods of preparation of (S)-citalopram oxalate crystalline forms wherein the solvent is ethyl acetate, methyl tert-butyl ether, acetonitrile, methanol or isopropyl alcohol. Since the reference does not disclose or suggest this, there is no motivation to employ the process taught by the'590 Boegesoe patent to crystallize (S)-citalopram oxalate and expect to obtain the desired product to reach the limitations of the claims, with the claimed polymorphic form, and no expectation of success.

In addition, with regard to the additional references cited by the Examiner, U.S. 2005/0137255, U.S. 2007/0117992, U.S. 2007/0129561, and U.S. 2008/0161584 are all post-

filing references, and thus are not proper references under 35 USC 103.

In addition, with regard to the 2005/0137255 reference, in addition to being a post-filing reference, Example 1 shows results from different solvents, but please note the differing melting points of the (S)-citalopram crystallized from the different solvents, an indication that they are different forms of (S)-citalopram. In addition, there is not any XRPD data disclosed in the 2005/0137255 reference to show that the (S)-citalopram isolated from different solvents has the same polymorphic form.

With regard to U.S. 2002/01777722, while this reference shows the crystallization of (S)-citalopram from acetone, it does not disclose the polymorphic form of the (S)-citalopram. With regard to U.S. 2004/0259949, this reference shows the crystallization of (S)-citalopram from ethanol, but does not disclose the polymorphic form of the (S)-citalopram crystallized.

Accordingly, reconsideration and withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

* * *

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.

February 12, 2009

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Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.